

REMARKS

Claims 1-16 were presented for examination and were rejected. Reconsideration of this application in view of the following remarks, and allowance of all claims herein, claims 1-16 as written, are hereby respectfully requested.

The Examiner enclosed with the Office Action a Notice of Draftsperson's Patent Drawing Review, in which the USPTO's draftsperson objected to the drawings submitted with the original application on July 30, 1999. However, formal drawings overcoming these objections were submitted to the USPTO on August 30, 1999. The examination of this application should be based upon said formal drawings.

In her fourth paragraph, the Examiner rejected claim 14 under the judicially created doctrine of double patenting over claim 1 of U.S. patent 5,978,917 under the obscure Schneller doctrine. As stated in MPEP §804, non-statutory double patenting rejections based on Schneller are rare. The Technology Center (TC) director must approve any non-statutory double patenting rejections based on Schneller.

The Examiner stated that claim 14 of '821 is a broader variation to claim 1 of '917, since claim 14 of '821 dispenses with the emulator of claim 1 of '917. This statement is incomplete. Claim 14 of '821 is also a narrower as well as a broader variation to claim 1 of '917, because said claim 14 contains the limitation that there is code associated with the

digital computer containing "instructions causing a macro to be moved to a global environment and said code also contains instructions causing the same macro to be copied to a local document". This limitation is not present in claim 1 of '917. Because of this, claim 14 of '821 and claim 1 of '917 are independent and distinct. As stated in Schneller, if the claims in question are independent and distinct, a double patenting rejection is not appropriate.

Another reason why the claims are independent and distinct is that an emulator is not recited in claim 14 of '821, whereas emulation is required in all of the claims of '917.

The facts of Schneller were unique, as stated in MPEP §804. In Schneller, the patentee obtained a patent claiming a clip comprising BCX and ABCX, claiming these combinations in such a way as to cover them no matter what other feature is incorporated in them, thus effectively covering ABCXY. Many years later, the patentee sought claims directed to ABCY and ABCXY. There is no analogous situation in the present case. If the Examiner believes that there is, she is requested to point out what in Applicant's claims are analogous to A, B, C, X, and Y.

For the above reasons, the Examiner is requested to withdraw her rejection of claim 14, and to allow this claim as written.

In her fifth paragraph, the Examiner rejected claims 1-16 under 35 U.S.C. §102(e) as being anticipated by Chi, U.S. patent 5,978,917. This rejection is traversed. The sole inventor of each of the '917 patent and the instant application is the same

person, Darren Chi. The claims of the '917 patent and the instant application do not overlap, so double patenting does not apply (see above discussion).

The law is well settled that, absent a statutory time bar, as in 35 U.S.C. §102(b), one's own work cannot be used as prior art against a later filed application.

This point of law was enunciated by the Court of Customs and Patent Appeals, which held: "Disclosure to the public of one's own work constitutes a bar to the grant of a patent claiming the subject matter so disclosed (or subject matter obvious therefrom) only when the disclosure occurred more than one year prior to the date of the application, that is, when the disclosure creates a one-year time bar, frequently termed a 'statutory bar', to the application under §102(b)." In re Katz, 215 USPQ 14, 17 (CCPA 1982).

The CCPA went on to say: "As stated by this court in In re Facius, 56 CCPA 1348, 1358, 408 F.2d 1396, 1406, 161 USPQ 294, 302 (1969), 'But certainly one's own invention, whatever the form of disclosure to the public, may not be prior art against oneself, absent a statutory bar.' [Emphasis in original.] Since any valid rejection is necessarily a 'statutory bar,' in a generic sense, the expression 'statutory bar' must be understood here as meaning 'statutory time bar' under 35 U.S.C. 102(b)." In re Katz, supra, at 17.

The Chi '917 patent issued November 2, 1999, while the present patent application was filed July 30, 1999. In other words, the two applications were copending for a period. Thus, the disclosure to the public of the information in the '917 patent does not create a statutory time bar against the present application under Section 102(b). Hence, the '917 patent is not "prior art" with respect to the instant application.

In re Katz, In re Facius, and related cases are discussed in Walterscheid, E.C., "The Ever Evolving Meaning of Prior Art (Part 5)", Jour.Pat.Off.Soc., Vol. 65, No. 9, p. 477 et seq. (Sept. 1983).

It is well settled that one cannot look to Applicant's skill in the art in determining the ordinary skill of a hypothetical artisan at the time the invention was made. Jad Corp. of America v. Hico Corp. of America, 335 F. Supp 66, 173 USPQ 245 (S.D.N.Y. 1971). In the present case, the level of ordinary skill of one practicing in the art at the time the present application was filed on July 30, 1999 did not include the content of Applicant's earlier copending application (which ultimately issued on November 2, 1999), since no one in the art other than Applicant had knowledge of the content of that application.

Where the inventor's earlier patent was copending with the present application, it cannot be considered as prior art. Louis A. Grant v. Keibler Industries, 181 USPQ 1 (N.D. Indiana 1973). This point was also raised in the case of Briggs v. M&J Diesel Locomotive Filter, 144 USPQ 701 (7th Cir. 1965), wherein the Court stated:

"...copending applications of the same inventor are not prior art to each other..."


This doctrine is also discussed in Weatherhead v. Drillmaster Supply, 107 USPQ 184 (7th Cir. 1955).

Copies of all cases and articles cited herein are enclosed herewith, except for In re Schneller, which was previously submitted by the Examiner.

For the above reasons, the Examiner is requested to withdraw her rejection of claims 1-16, and to allow these claims as written.

Applicant believes that this application is now in condition for allowance of all claims herein, claims 1-16 as written, and therefore an early Notice of Allowance is respectfully requested. If the Examiner disagrees or believes that, for any other reason, direct contact with Applicant's attorney would help advance the prosecution of this case to finality, she is invited to telephone the undersigned at the number given below.

Respectfully submitted,



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